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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/476,078

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Charles Eric Hunter

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EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,078

Applicant(s)

HUNTER, CHARLES ERIC

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-28, 30 and 31 have been examined.

Response to Amendments/Arguments

2. Applicant's claims were rejected over Schulhof et al. in view of Neville et al.. Initially, the Applicant attempts to overcome the rejection by pointing out what Neville et al. does and does not teach. On the other hand, Schulhof et al. clearly teach, what Applicant alleges, and the Examiner respectfully disagrees-'636, column 13, lines 8-12, Neville et al. lack. For example, Applicant is of the opinion that Neville et al. do not teach storing "previously recorded content" (Response, dated 2-27-06, pages 11 and 12). However, this is a feature taught by Schulhof et al. (column 8, lines 50-67), and it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (*In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), therefore the combined teachings of Schulhof et al. and Neville et al. clearly read on Applicant's claims. Applicant also asserts that the prior art does not teach "generating a permanent enabling code for inclusion with said permanent recorded music selections to thereby enable unrestricted payback". On the other hand, Applicant's Specification merely recites a storage medium

receiving an enabling code (Specification, page 33, lines 11-14). Again Applicant is not considering the combined teaching. The Examiner explicitly stated in the previous Office Action that Neville et al. teach sending an enabling code to allow further use of the previously recorded product after the trial period had expired (abstract; column 13, lines 5-44). Hence, the combined references teach Applicant's generating an enabling code and sending the code *to the storage medium* (Specification, page 33, lines 11-14) where the pre-recorded content is stored in order enable unrestricted playback.

The Examiner maintains the rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-28, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al., U.S. Patent No. 5,572,442 in view of Neville et al., U.S. Patent No. 6,272,636.

As per claims 1-28, 30 and 31, Schulhof et al. teach a method for distributing music comprising:

- blanket transmitting, at faster than real time speeds, simultaneously a plurality of music selections to a plurality of customer households for receipt on a plurality of inputs (figures 1 and 5-7; column 5, lines 50-60)
- a first interface enabling at least one customer to preselect and record transmitted music selections in a read/write storage medium (e.g. read/write CDs, magneto-optical disks, digital tape) (abstract; figures 1, 4, and 6; column 5, lines 6-20 and 50-67; column 7, lines 5-53; column 8, lines 60-67; column 12, lines 54-67)
- a second interface permitting the customer to select recorded music for unrestricted playback (figures 1, 4, and 6; column/line 4/48-5/20; column 5, lines 50-67; column 7, lines 5-53; column 9, lines 20-26)
- communicating unrestricted playback selection information to a central controller, via satellite, cable,...etc., and billing the customer for the selected unrestricted playback (column/line 4/48-5/20; column 6, lines 24-52; column/line 7/54-8/2; column 9, lines 20-26; column 10, lines 42-65)
- selection information that includes availability, scheduling and price data (column 5, lines 60-64; column 7, lines 27-33 and 45-53; column/line 7/61-8/4; column 9, lines 26-38)

- an interactive guide, via a display device, to allow users to make content selections, and select functions to playback and record content (abstract; figures 1-4, 6 and 7; column 7, lines 27-53; column/line 9/65-10/15; column/line 11/65-12/10; column 12, lines 54-67; column 13, lines 10-28; column 14, lines 18-26 and 39-55)
- receiving and decoding musical selections and storing decoded selections and associated information in a digital data storage device for temporary storage (figures 2, 3 and 7; column 9, lines 26-38; column 12, lines 10-18 and 29-67)
- accessing the content over the internet link to a website or phone line connection (figure 1; column 7, lines 35-52)
- allowing users to access content one or more times on a no-charge basis prior to permanently selecting the content (column 9, lines 27-37)
- generating a permanent enabling code for inclusion with the permanent recorded music selections to enable unrestricted playback (column 9, lines 27-37)
- communicating with a broadcast satellite up-link facility, operating in the KU or other suitable frequency bands, via a central controller,

and transmitting program/pricing information to the broadcast facility on a periodic basis (figures 5 and 7; column 6, lines 24-52)

Schulhof et al. teach a system for transmitting audio content to a plurality of users, where users can record and playback content using a plurality of interfaces, and are billed for using the content distribution service (figures 1 and 4-7; column/line 4/48-5/67; column 6, lines 24-34; column/line 7/54-8/2). Schulhof et al. do not specifically recite using DVD-RAM to record content. However, Schulhof et al. teach that digital, optical, magnetic or other high density, high capacity can be used. Therefore, it would have been obvious to one of ordinary skill to use DVD-RAM for portable storage (column 4, lines 55-67; column 8, lines 59-67; column 12, lines 54-64). Similarly it would have been obvious to one of ordinary skill to store a plurality of disks with content recorded thereon.

However, Schulhof et al. do not specifically recite "permitting the at least one customer household to select previously recorded music selections, that were previously recorded by the at least one customer household in the storage medium for unrestricted playback", nor does Schulhof et al. teach generating enabling codes subsequent to the recording of music wherein said codes enable unrestricted playback. Neville et al. teach allowing users to access content stored on a user device on a trial basis, then sending an enabling code to allow further use of the previously recorded product after the trial period had expired (abstract; column 13, lines 5-44). Regarding Therefore, it would have been obvious to one

of ordinary skill to combine the teachings of Schulhof et al. and Neville et al. to allow consumers to evaluate a fully functional product while protecting content providers from malicious use on the part of the consumer ('442, column 9, lines 27-37; '636, column/line 1/35-5/35).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

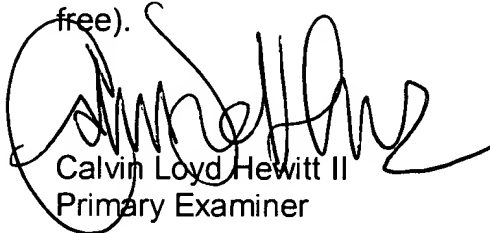
or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over the printed name and title.

Calvin Loyd Hewitt II
Primary Examiner

April 28, 2006